

REMARKS

In the last Office Action, claims 7-16 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,078,738 to Garza. Applicant respectfully traverses this rejection and submits that Garza does not disclose all of the structural and functional limitations recited in independent claims 7, 16 and corresponding dependent claims 8-15.

In rejecting claims 7-16 under 35 U.S.C. §102(b), the Examiner recognized that Garza does not disclose or describe the explicitly recited functions performed by the components of the apparatus recited in claims 7-16. As to these limitations, the Examiner states that "the CAD system of Garza would be capable of performing all the functional limitations in these claims." Applicant vigorously disagrees with the Examiner's contention and conclusion of anticipation.

A rejection for anticipation under 35 U.S.C. §102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. In addition, the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention. In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The Examiner's mere contention that the CAD system of Garza would be "capable" of performing all of the functional limitations recited in claims 7-16 is insufficient to support an anticipation rejection because "capability" alone does not equate to "anticipation". Stated otherwise, in a claim containing both structural and functional limitations, the disclosure of only the claimed structural limitations by a prior art reference is insufficient to make a prima facie case of anticipation. The functional limitations must also be either explicitly disclosed by the prior art reference or be found to be inherent in the prior art reference.

In this case, the Examiner has recognized that Garza does not explicitly disclose the functional limitations recited in the claims. Furthermore, with respect to these functional limitations, the Examiner has also not relied upon a theory of inherency, which requires the Examiner to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic (i.e., the functional limitations) necessarily flows from the teachings of the applied prior art. (See, Continental Can Co. USA v. Monsanto Co., 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991)).

Additionally, the specific functional limitations recited in the claims are not inherent in Garza. Even assuming that the CAD system of Garza is, as the Examiner stated, "capable of performing all the functional limitations" recited in claims 7-16, there is no disclosure thereof in Garza and persons of ordinary skill in the art would not have recognized such a result.

Moreover, unless the "means for reading first and second CAD data", the "means for displaying the first and second CAD data", the "designating means", and the "means for sampling, calculating and controlling" purportedly disclosed by Garza perform the identical corresponding functions specified in claims 7-16, they cannot be equivalents for the purposes of Section 112, 6th paragraph. Pennwalt Corp. v. Durand-Wayland, Inc., 4 USPQ2d 1737 (Fed. Cir. 1987). In this regard, there is no teaching in Garza, for example, of "means for reading first CAD data used to form the already formed pattern of the semiconductor device and reading second CAD data to be used to form another pattern of the semiconductor device that will be connected to the already formed pattern" and "means for displaying the first and second CAD data with the displayed image of the already formed pattern as an overlapped image on the monitor to enable evaluation of a deviation of the already formed pattern from the first and second CAD data", as recited in independent claim 7.

Moreover, the combination of features, including the explicitly recited functional limitations, required by claims 7-16 is not suggested by Garza and, therefore, one ordinarily skilled in the art would not have been led to modify Garza to attain the claimed subject matter. See, inter alia, In re Fine, 5 USPQ2d 1596, 1598, (Fed. Cir. 1988), and Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), cert. denied.

In view of the foregoing, applicant respectfully requests that the rejection of claims 7-16 under 35 U.S.C. §102(b) as being anticipated by Garza be withdrawn.

In view of the foregoing discussion, the application is now believed to be in condition for allowance. Accordingly, favorable reconsideration and allowance of the claims are most respectfully requested.

Respectfully submitted,

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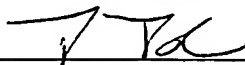
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